

Serial No. 10/634,732 filed 8/5/2003  
Amendment dated Feb. 2, 2005  
Response to Office Action of Aug. 2, 2004

### **Amendments to the Drawings**

Further to the Examiner's request, a corrected drawing sheet is attached hereto. The attached sheet includes changes to Figures 10a and 10b. This sheet, which includes Figures 10a, 10b, and 10c, replaces the original sheet including Figures 10a, 10b, and 10c.

In the attached corrected sheet, Figure 10b has been annotated with reference numeral "8" for the cap. Reference numeral "496" in Figure 10a has been corrected to read "494", and Figure 10b has been annotated with the reference numeral "494".

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#### Remarks

Receipt is acknowledged of the Office Action of August 2, 2004. Reconsideration of the application and a three month extension of the time provided for response are respectfully requested. The Commissioner is hereby authorized to debit all amounts deemed required from Deposit Account No. 50-1604.

#### Specification and Drawings

Further to the Examiner's request, the specification and drawings have been amended as set forth above, and a new abstract has been added hereto.

#### Rejections Under 35 U.S.C. §112

In the Office Action, various of the claims were rejected under 35 U.S.C. §112, second paragraph. Further thereto, the claims have been amended to address the Examiner's rejections as follows:

Claims 1, 14, and 27 have been amended to remove the term "of said baby bottle nipple".

Claims 1 and 27 have been amended to change the term "bottom surface" to "lower surface".

Claim 14 has been amended to provide antecedent basis for the terms "said bottom wall", "said upper surface" and "said lower surface".

Claims 9 and 10 were amended to remove the language reciting that the outer wall comprises a tip.

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Typographical errors in Claim 14 and 32 have also been corrected (deletion of the redundant word "towards" in Claim 14, and "comprising" in Claim 32).

Accordingly, reconsideration and withdrawal of the rejections is respectfully requested.

Rejections Under 35 U.S.C. §103(a)

In the Office Action, the claims were also rejected under 35 U.S.C. §103(a) based upon various combinations of references. Reconsideration of the rejections is respectfully requested.

In the Office Action, Claims 1-3, 8, 9, and 11-13 were rejected based upon Morifuji (U.S. Patent No. 5,101,991) in view of Brown et al. (U.S. Patent No. 5,439,143 or "Brown '143"). Reconsideration of the rejections is respectfully requested.<sup>1</sup>

All of the pending claims are directed to providing a device for use as a no-spill drinking apparatus. Brown '143, however, relates to an entirely different type of use than recited in the claim, such that the reference is non-analogous art. Brown '143 does not relate to drinking, or to no-spill drinking devices. Rather, it teaches a fluid dispenser for dispensing products such as liquid soaps, shampoos, conditioners, and so forth. It is respectfully submitted that soap dispensers are not within the field of applicant's endeavor (no-spill drinking devices), nor reasonably pertinent to the problem which the inventor faced.

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<sup>1</sup> New Independent Claim 40 and its dependents have also been added with the present amendment. Claim 40 is a slightly broader version of Claim 1 in which the outer surface of the lower surface of the bottom wall need not be curved. This claim is patentable for the same reasons discussed with respect to Claim 1, as set forth in the present response.

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Furthermore, it would not be obvious to one of ordinary skill to use the structure of the Brown '143 device to achieve the functions recited in the pending claims. The pending claims are directed to providing an apparatus for preventing spilling of liquid when the user is not drinking. In such devices, it is necessary that the valve resist opening when pressure is exerted against the liquid side of the valve. Such pressure can be exerted, for example, via shaking. If the valve could not resist such pressure, it would spill.

In contrast, the structure in Brown '143 is one specifically designed to open when pressure is exerted from the liquid side of the valve. This, in fact, is the entire purpose of the Brown '143 structure – to open and allow liquid to emerge when pressure is exerted from the liquid side. In other words, Brown '143 is designed to do the very opposite of what would be needed in a no-spill apparatus.

Brown '143 is likewise a valve designed to be used with container overpressure, wherein pressure within the container (e.g. via squeezing) is used to open the valve. No such configuration of forces is used with no-spill drinking cups, nor would they be desirable. Use of such a principle would allow a child to spill the liquid contents on the floor merely by squeezing the cup, which violates the cup's purpose.<sup>2</sup>

In view thereof, it is submitted that would not be obvious in any manner to combine the teachings of Brown '143 with those of Morifuji. Considering its contrary purpose, it would not be obvious to use the Brown '143 structure as part of a no-spill device. Moreover, when the proposed modification or combination of references would change the principle of operation of the device being

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<sup>2</sup> Such a principle, which requires a compressible fluid holding container, is also inconsistent with new claims 41 and 44-46, which recite a hard cup.

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modified, as is the case here, the teachings of the references cannot be sufficient to render the claims obvious. *See e.g.*, MPEP §2143.01 (Eighth Ed. Rev. 2, May 2004, p. 2100-132).

In the Office Action, Claims 14-16, 18, 21, 22, and 24-26 were rejected based on Morifuji (U.S. Patent No. 5,101,991) in view of White (U.S. Patent No. 4,623,069). Reconsideration of the rejection is respectfully requested.<sup>3</sup>

Claim 14 (and its dependents) require that the protrusions are used to bend a bottom wall of the valve, such that liquid can pass through the opening in that bottom wall. As discussed in White, however, the enlarged end portions therein fulfill the opposite purpose. The enlarged end portions in White restrict fluid flow when the outer wall is compressed as recited in the claims. *See*, White col. 5 lines 6-9 ("Compression by an infant at either the first or second troughs will partially restrict flow through the annular chamber 32 and out the dispensing apertures 32") (emphasis added herein). This is contrary to the recitation of the claims, in which the protrusions are used to facilitate opening of a passageway to allow liquid flow.

White, therefore, teaches away from the present invention. The principle taught by White for use of protrusions is to achieve a function (restriction of fluid flow) which is contrary to what is recited in the claim (facilitating of fluid flow). *See*, MPEP 2145 X.D.2 (Eighth Ed. Rev. 2, May 2004, p. 2100-162) ("It is improper to combine references where reference teaches away from their combination").

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<sup>3</sup> It is noted that, in the Office Action, it was not indicated where any protrusions are in White. It is assumed that the Examiner is referring to enlarged end portion 60 of the internal member (as shown for example in White's Figure 2).

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As mentioned above, when the proposed modification or combination of references would change the principle of operation of the device being modified, then the teachings of the references cannot be sufficient to render the claims obvious. *See e.g.*, MPEP §2143.01 (Eighth Ed. Rev. 2, May 2004, p. 2100-132). Accordingly, it is submitted that to combine White with Morifuji to achieve a purpose using the White reference which is the opposite of what White teaches, would not at all be obvious.

In the Office Action, Claims 27-29, 31, 34, 35 and 37-39 were rejected over the references as applied to Claim 1, and further in view of Bachman et al. (U.S. Patent No. 5,890,621). Reconsideration of the rejection is respectfully requested.

With respect to the references previously applied to Claim 1, it would not be obvious to combine them, as discussed above. Moreover, with respect to Bachman, the combination of Bachman and Morifuji does not achieve the claimed structure. The configuration shown in Bachman is upside down from that which is recited in the claim. A comparison of the upper and lower surfaces of the bottom wall claimed in the Claim 27 and its dependents, and the structure shown in Bachman (*see e.g.*, Figure 15) shows that the Bachman configuration is reversed from what the claims require. *See also*, Application Figure 7.

Nor is the operation of the Bachman device consistent with the structure recited in Claim 27 and the claims dependent thereon. As recited and required in those claims, when the user places his or her mouth on the outer wall to compress that outer wall, the inner surface of the outer wall will contact the protrusion. It does not appear that this ever occurs in the Bachman device. In Bachman, the outer wall does not compress. *See e.g.*, Bachman Figures 16-18. Nor does the outer wall appear to contact any

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protrusion even in an open state. *See e.g.*, Bachman Figure 17. If the Examiner believes that compression and contact is, in fact, occurring, it is respectfully requested that the citations for these teachings be provided. However, in any event, as discussed above, the Bachman configuration does not teach or suggest what the claims require, but is the reverse of the recitation in the claims.

In the Office Action, Claims 4, 17 and 30 were rejected over the references applied to Claims 1, 14, and 27 above and further in view of Brown (U.S. Patent No. 4,600,111 or "Brown '111"). Reconsideration of the rejections is respectfully requested.

With respect to Brown '111, the reference merely recites a sealing lid 26 with an extended spout. There is no teaching or suggestion in Brown '111 (or in any of the other references), to provide the specific claimed valve structure recited in the claims, as discussed above with respect to the rejections applied to Claims 1, 14 and 27.

In the Office Action, Claims 6, 7, 19, 20, 32 and 33 were rejected over the references applied to Claims 1, 14 and 17 above, and further in view of Hung (U.S. Patent No. 6,230,923 B1). Reconsideration of the rejections is requested.

As discussed above, there is no teaching or suggestion in the references cited to provide the inventions of the independent claims (Claims 1, 14, and 17) as discussed above. Moreover, Hung takes the prior art (see, Hung Figure 1) and removes the bottom wall entirely (see, Hung Figure 3). This is contrary to all of the cited claims, all of which include a bottom wall. Accordingly, the recited claims would not be obvious over Hung.

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In the Office Action, Claims 10, 23, and 36 were rejected over the references applied to Claims 1, 14 and 28 above in view of Lougheed (U.S. Patent No. 2,223,179).

Each of Claims 10, 23 and 36 requires that the bottom wall be located near the widened portion of the tip of the outer wall. Presumably, this rejection is based upon Figure 5 in Lougheed. However, Lougheed is again contrary to the purposes of the invention, and to the functions and design recited in the claim. Lougheed indicates that embodiments such as shown in Figure 5 are designed to prevent them from being pinched open by the mouth. *See*, Lougheed col. 3 line 68-col. 4 line 6 (the Lougheed slit is made so that "any possibility of it pinching open unwantedly as by tongue or lip is eliminated"). In contrast, Claims 1, 14 and 27 (the independent claims for claims 10, 23 and 36 respectively), all indicate that the mouth on the outer wall causes opening of the passage for liquid (by bending the bottom wall structure provided in the device). Accordingly, Lougheed is another example of a reference teaching away from the present invention, which is further evidence of non-obviousness.

Thus, it is respectfully submitted that the references cited do not show obviousness. Moreover, they do not lead to the invention, but rather lead away from it, which is strong evidence of non-obviousness.

It is also respectfully submitted that the present inventions are not obvious as a matter of the applicable legal standards. As set forth in MPEP §2143, for example, the basic requirements of a *prima facie* case of obviousness are as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the



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reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

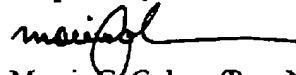
*See*, MPEP §2143.01 (Eighth Ed. Rev. 2, May 2004, p. 2100-129).

However, no showing of a teaching or suggestion has been cited in the references themselves or in the knowledge generally available to one of ordinary skill in the art, either to modify the references or to combine the cited references teachings. The only such motivation is within Applicant's disclosure. There is also no showing of a reasonable expectation of success – except via Applicant's disclosure which was itself based upon research and development to arrive at the features of the invention. Lacking such showings, the invention should be deemed non-obvious. *See*, MPEP §2143, quoting, *In re Vaacke*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (for a finding of obviousness “The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure”). Furthermore, as discussed above, in numerous instances the references when combined do not even teach or suggest the necessary claim limitations.

Accordingly, in view of the foregoing, reconsideration of the rejections is requested. Favorable action on the application is respectfully requested and believed fully warranted.

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Respectfully submitted,



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